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60,469-094 PUS1
OT-5208 LAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Miller, et al. International App. No.: PCT/US03/39076
Serial No.: 10/580,939 International Filing Date: 9 December 2003
Filed: 05/30/2006
Art Unit: 3654
Examiner: Kruer, Stefan
For: GUIDE RAIL FOR AN ELEVATOR SYSTEM

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed June 11, 2008.

Applicant respectfully traverses the restriction requirement and respectfully requests reconsideration. The Examiner should withdraw the election requirement.

As this case is a national phase filing based upon a PCT application, it is subject to PCT Rules 13.1 to 13.4. MPEP §1893.03(d) states:

When making a lack of unity of invention requirement, the Examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

Applicant respectfully submits that, while the Examiner states he is using unity of invention, it appears that the restriction is based on U.S. practice under MPEP §800.

Under PCT Rules 13.1 and 13.2, a group of inventions is considered linked to form a single general inventive concept when there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The MPEP Appendix A1 sets forth the administration instructions under the PCT (see Annex B, Unity of Invention, Part 1, instructions concerning unity of invention). Those instructions explain:

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Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. See, Annex B, Unity of Invention, Part 1(c)(i).

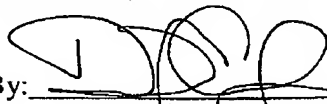
In this case, the technical relationship among the inventions involve the common or corresponding technical feature that is found in each of the independent claims 1, 8, 10, 13, 14, 19 and 20. Each of those claims includes a guide rail body of a first material and a second material on at least a portion of the rail. Accordingly, no restriction can be imposed in this application without the Examiner first performing an examination and citing to the prior art that would make the claims not patentable. Without that, the restriction requirement is baseless and must be withdrawn. Pointing to a different classification or a "separate status in the art" is not a proper basis for a restriction requirement in this application.

The claims presented in the Preliminary Amendment are consistent with those considered during the international examination phase and were found to meet the requirements of PCT Articles 33(2)-(3).

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Applicant believes that the restriction requirement should be withdrawn. Applicant hereby provisionally elects, with traverse, claims 1-13 and 21.

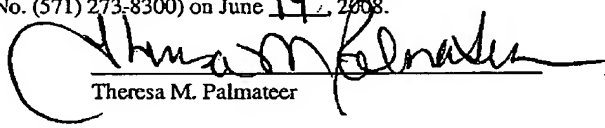
Respectfully submitted,
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Dated: June 19, 2008

CERTIFICATE OF FACSIMILE

I hereby certify that this Response, relative to Application Serial No. 10/580,939, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on June 19, 2008.


Theresa M. Palmateer

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